

REMARKS

In the Office Action, the Examiner rejected claims 1-27 under the judicially created doctrine of obviousness-type double patenting. The Examiner also rejected claims 1-13, 16, and 18-27 under 35 U.S.C. § 102(e) as being anticipated by *Waldo et al.*, U.S. Patent No. 6,185,611 (hereafter, *Waldo*) and claims 14-15 under 35 U.S.C. § 103(a) as being unpatentable over *Waldo*. Finally, the Examiner rejected claim 17 under 35 U.S.C. § 102(e) as being anticipated by *Miller*, U.S. Patent No. 5,506,984.

By this Amendment, Applicants have amended claims 1, 6, 13, 17, 18, 19, and 24 to point out aspects of the invention, taking care not to add any new matter.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1 through 27 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 6, 13, 17-19 and 24 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Double Patenting Rejections

In rejecting claims 1-27 under the judicially created doctrine of obviousness-type double patenting, the Examiner alleged that the application claims are not patentably distinct from the claims of *Waldo*. Amended claims 1, 6, 13, 17, 18, 19, and 24 include several patentable distinctions over the invention claimed in *Waldo*.

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For example, claim 1 recites, among other things, receiving a request for access to a lookup service of interest to a client, the request including a service characteristic of interest to the client and a time period. The claims of *Waldo* do not teach anything similar to this request. Instead, *Waldo* claims broadcasting an object by a client, the object containing code for communicating with the client. Nothing in the claims of *Waldo* suggests the step of receiving a request including a service characteristic of interest to a client and a time period. Therefore, claim 1, and its dependent claims, are patentably distinct from *Waldo*, and Applicants request the withdrawal of the double patenting rejections of claims 1-5.

Amended claim 6 recites the steps of transmitting a request by a client, the request including a characteristic of a desired lookup service and locating, as a function of the characteristic of the desired lookup service, a lookup service. *Waldo* does not claim or suggest these steps. Instead, the claims of *Waldo* recite a distributed system with a lookup service and a discovery server that uses code received from a client to send to the client a reference to the lookup service. Not only does *Waldo* not claim locating, as a function of a characteristic of the desired lookup service, a lookup service, but there would be no need for this step in a distributed system with only one lookup service, as claimed in *Waldo*. Therefore, claim 6 and its dependent claims are patentably distinct from *Waldo*, and Applicants request the withdrawal of the double patenting rejections of claims 6-12.

Claim 13, as amended, recites locating, by a lookup discovery service, a lookup service matching a characteristic of interest until a time period previously specified by a

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client expires. *Waldo* does not claim any type of time period specified by a client, nor does it claim locating a lookup service matching a characteristic of interest. Therefore, claim 13 and its dependent claims are patentably distinct from *Waldo*, and Applicants request the withdrawal of the double patenting rejections of claims 13-16.

Amended claim 17 recites a program that transmits a request including a characteristic of lookup services that interest the program and a time period. The claims of *Waldo* do not teach anything similar to this program. Instead, *Waldo* claims broadcasting an object by a client, the object containing code for communicating with the client. Because nothing in the claims of *Waldo* suggests a program that transmits a request including a characteristic of lookup services that interest the program and a time period, claim 17 is patentably distinct from *Waldo*, and Applicants request the withdrawal of the double patenting rejections of claim 17.

Claim 18, as amended, recites means for sending a request by a client for access to a lookup service meeting criteria specified in the request together with means for searching for lookup services that meet the criteria. *Waldo* does not claim or suggest these elements. Instead, the claims of *Waldo* recite a distributed system with a lookup service and a discovery server that uses code received from a client to send to the client a reference to the lookup service. Not only does *Waldo* not claim searching for lookup services that meet the criteria, but there would be no need for searching in a distributed system with only one lookup service, as claimed in *Waldo*. Therefore, claim 18 is patentably distinct from *Waldo*, and Applicants request the withdrawal of the double patenting rejections of claim 18.

Amended claim 19 recites a computer readable medium containing instructions for performing a method similar to that recited in claim 1. Therefore, claim 19 and its dependent claims are patentably distinct from the claims of *Waldo* for at least the reasons given above with respect to claim 1, and Applicants request the withdrawal of the double patenting rejections of claims 19-23.

Amended claim 24 recites a computer readable medium containing instructions for performing a method similar to that recited in claim 6. Therefore, claim 24 and its dependent claims are patentably distinct from the claims of *Waldo* for at least the reasons given above with respect to claim 6, and Applicants request the withdrawal of the double patenting rejections of claims 24-27.

Section 102 Rejections

In the Office Action, the Examiner rejected claims 1-13, 16, and 18-27 under 35 U.S.C. § 102(e) as being anticipated by *Waldo*. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed. 2001, revised February 2003). Because *Waldo* does not teach every element of claims 1-13, 16, and 18-27, as amended, Applicants request the withdrawal of the section 102 rejections.

For example, claim 1 recites, among other things, receiving a request for access to a lookup service of interest to a client, the request including a service characteristic of interest to the client and a time period. *Waldo* does not teach anything similar to this step. Instead, *Waldo* teaches a client that sends a multi-cast packet with code for communicating with the client. (*Waldo*, col. 10, ll. 51-59.) Nothing in *Waldo* suggests the step of receiving a request including a service characteristic of interest to a client

and a time period, as recited by claim 1. For at least this reason, *Waldo* fails to teach every element of claim 1, as well as the claims that depend therefrom. Therefore, Applicants request the withdrawal of the section 102 rejections of claims 1-5.

Amended claim 6 recites the steps of transmitting a request by a client, the request including a characteristic of a desired lookup service and locating, as a function of the characteristic of the desired lookup service, a lookup service. *Waldo* does not disclose these steps. Instead, *Waldo* discloses a discovery server that receives a packet containing code for communicating with a client and uses that code to send a reference to a lookup service to the client. (*Waldo*, col. 10, ll. 60-64.) Nothing in *Waldo* teaches that a client's request includes a characteristic of a desired lookup service or locating, as a function of the characteristic of the desired lookup service, a lookup service, as recited in claim 6 and the claims that depend therefrom. Because *Waldo* fails to teach every element of claim 6 and its dependent claims, Applicants request the withdrawal of the section 102 rejections of claims 6-12.

Claim 13, as amended, recites locating, by a lookup discovery service, a lookup service matching a characteristic of interest until a time period previously specified by a client expires. As discussed above, *Waldo* does not disclose a time period specified by a client, nor does it disclose locating a lookup service matching a characteristic of interest. Therefore, Applicants request the withdrawal of the section 102 rejection of claim 13 and claim 16, which depends therefrom.

Claim 18, as amended, recites means for sending a request by a client for access to a lookup service meeting criteria specified in the request together with means

for searching for lookup services that meet the criteria. *Waldo* does not claim or suggest these elements. Instead, *Waldo* discloses a discovery server that receives a packet containing code for communicating with a client and uses that code to send a reference to a lookup service to the client. (*Waldo*, col. 10, ll. 60-64.) Nothing in *Waldo* teaches that a client's request includes a criteria or searching for lookup services meeting that criteria, as recited in claim 18. Because *Waldo* fails to teach every element of claim 18, Applicants request the withdrawal of the section 102 rejection of claim 18.

Amended claim 19 recites a computer readable medium containing instructions for performing a method similar to that recited in claim 1. Therefore, for at least the reasons given above with respect to claim 1, *Waldo* fails to disclose every element of claim 19 and its dependent claims, and Applicants request the withdrawal of the section 102 rejections of claims 19-23.

Amended claim 24 recites a computer readable medium containing instructions for performing a method similar to that recited in claim 6. Therefore, for at least the reasons given above with respect to claim 6, *Waldo* fails to disclose every element of claim 24 and its dependent claims, and Applicants request the withdrawal of the section 102 rejections of claims 24-27.

The Examiner also rejected claim 17 under 35 U.S.C. § 102(e) as being anticipated by *Miller*. However, *Miller* fails to disclose every element of amended claim 17. For example, claim 17 recites a program that transmits a request including a characteristic of lookup services that interest the program and a time period. The

claims of *Waldo* do not teach anything similar to this program. Instead, *Waldo* teaches a client that sends a multi-cast packet with code for communicating with the client. (*Waldo*, col. 10, ll. 51-59.) Nothing in the claims of *Waldo* suggests a program that transmits a request including a characteristic that interests a client and a time period, as recited by claim 17. For at least this reason, *Waldo* fails to teach every element of claim 17, and, Applicants request the withdrawal of the section 102 rejection of claim 17.

Section 103 Rejections

The Examiner rejected claims 14-15 under 35 U.S.C. § 103(a) as being obvious over *Waldo*. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First the reference must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8th ed. 2001, Revised February 2003). Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference in a manner resulting in the claimed invention. *Id.* at § 2143.01. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. *Id.* at § 2143.02. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." *Id.* at § 2143.

By their dependence from claim 13, claims 14 and 15 recite locating, by a lookup discovery service, a lookup service matching a characteristic of interest until a time period previously specified by a client expires. As discussed above, *Waldo* does not teach or suggest a time period specified by a client, nor does it teach or suggest